Remarks/Arguments:

Claims 1-27 are pending in the application, and claims 21-27 are withdrawn from prosecution. Claims 1-20 are amended to correct typographical errors and to cast the claims in preferred USPTO format. No new matter has been added.

Oath/Declaration

Applicants acknowledge the Examiner's observation that the Declaration filed with the application bears a different PCT number than is associated with the 371 papers, and will shortly submit a new Declaration along with the appropriate fee.

Rejection of Claims

Claims 1-20 are rejected under 35 USC § 103(a) as unpatentable over U.S. 4,640,838 ("Isakson"). Claim 1 (as amended) recites:

"A heat-sealable, composite film said film comprising a polymeric substrate layer having a first and second surface and disposed on a surface of the substrate layer a water-soluble barrier layer, wherein

(i) the substrate layer has one or more venting means therein; and

(ii) the thickness of the barrier layer is from about 0.05 to about 40 μm."

The rejection states that Isakson teaches a vent opening that is covered by a tape that has a soluble backing (Figure 4, Example 1). The rejection asserts that the thickness and composition of the water-soluble barrier layer recited in Applicants' claims would have been arrived at by the person of ordinary skill at the time of invention, depending on the desired seal strength, opening temperature, and opening pressure. Applicants respectfully disagree, for the following reasons.

Isakson does not teach the use of a barrier layer that is water-soluble as claimed, and the Office has presented no reason to modify Isakson's disclosure to make the barrier layer water-soluble. In the absence of such a reason, *prima facie* obviousness is not supported.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d)

"...a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR Int'l Co. v. Teleflex Inc.*, emphasis added.

Since the Office has not identified a reason that would have prompted the person of ordinary skill to use a water-soluble material for the barrier layer, this claim feature has not been provided and the rejection should be withdrawn.

Additionally, Isakson solves the problem of providing a self-venting packaging in an entirely different way than that described in the present application. Isakson relates to a vapor-tight package, wherein the outer surface of the packaging is provided with a material that converts microwave energy to heat-energy, which softens and weakens that portion of the packaging film over which it is disposed, therefore self-venting the packaging.

The rejection refers particularly to Figure 4 and Example 1. In Figure 4, a piece of tape which comprises a carrier web, a layer of non-metallic microwave absorbing particles and a means for adhering to the packages is used to cover a perforation in a plastic film. There is no disclosure in this embodiment of the presence of a water-soluble barrier layer as a constituent layer of the film.

Column 2, lines 52 to 61 of Isakson describes that where the deposit (e.g. the tape) is impervious to vapor but softens or weakens when heated by microwave energy, it can be placed over an opening, slit or score in a package. Isakson teaches that in such an arrangement, it may be desirable to cover the deposit with a vapor-impervious thermoplastic film. In this case, venting either occurs by weakening of the covering thermoplastic film as a consequence of the microwave heating effect or by lateral venting.

In contrast, the composite film of the present invention works in an entirely different way. The film comprises, as an essential component, a water-soluble barrier layer which, prior to heating, provides a physical barrier to the entry of external contaminants. However, upon heating, the water vapor generated in the package at least partially solubilizes the barrier layer

so as to allow self-venting of the container through the self-venting means provided in the substrate.

Contrary to the position adopted by the Office, a routine modification of Isakson would not bring the person skilled in the art to the present invention. In fact, to arrive at the subject matter of claim 1, the person skilled in the art would have had to go against the teaching in Isakson. In particular, in Isakson self-venting is achieved as a consequence of a microwave energy heating effect, whereas in the present invention, it is the water vapor generated during heating which is used to provide the self-venting effect. Against this background, there is no reason why the person skilled in the art would have made the necessary changes to the film described in Isakson to arrive at the claimed subject matter. When faced with the teaching of Isakson, the person skilled in the art might have focused on identifying alternative water vapor-impervious layers. But there is no apparent reason why that person would have replaced the vapor-impervious layer with a water soluble layer that is designed to be weakened by water vapor. Such a choice would have altered the behavior of the layer in response to water vapor in a manner inconsistent with Isakson's objectives. But, as noted in the MPEP at 2143.01 V:

> If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

Applicants submit that such is the case here, and that the rejection should therefore be withdrawn. Claims 2-20 depend from claim 1, and these should likewise be allowed.

Applicants respectfully request reconsideration and allowance of claims 1-20, and invite the Examiner to contact their representative, Frank Tise, if it appears that this may expedite examination.

Respectfully submitted,

Frank P. Tise

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FPT/pm

Dated: March 11, 2009

The Director is hereby authorized to charge or credit Deposit Account No. **18-0350** for any additional fees, or any underpayment or credit for overpayment in connection herewith.

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